

Application Serial No.: 10/659,246
Amdt. dated January 14, 2008
Reply to Final Office Action of July 12, 2007

REMARKS/ARGUMENTS

The Final Office Action dated July 12, 2007 and the references cited therein have been carefully considered. Applicants also thank the Examiner for the courtesies extended to Applicants' attorney during a telephone interview. In response to the Office Action, Applicants have amended Claim 46 to correct the typographical error noted in the Office Action. Applicants further respectfully request withdrawal of the final rejection with respect to Claims 69-71, 73-77, 88, 91, 93-97, 102 and 104.

Allowable Subject Matter

Independent Claim 46 and Claims 48, 49, 51-66, 68, 83, 89 and 90, which depend from Claim 46, have been deemed allowable if rewritten or amended to overcome the objection set forth in the Office Action. As mentioned above, Applicants have amended Claim 46 to correct the typographical error noted in the Office Action. Accordingly, it is believed that Claims 46, 48-49, 51-66, 68, 83 and 89 and 90 are now in condition for allowance.

Examiner's Official Notice

In rejecting the remaining claims, the Examiner states that the Applicant failed to challenge the Official Notice taken by the Examiner in the previous Office Action (February 14, 2006). The Examiner is incorrect.

From the start, Applicants have strenuously attempted to traverse the rejection of independent Claims 69 and 88, and the claims that depend therefrom. In doing so, Applicants have repeatedly challenged the Examiner's Official Notice taken with respect to these claims. In particular, in response to the February 14, 2006 Office Action, Applicants specifically argued that the features of the claims were not obvious to one having ordinary skill in the art. More particularly, Applicants expressly argued that the prior art only discloses printing on labels, layers of labels and the like and does not provide any indication whatsoever for

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printing directly onto a mold surface for transferring an image onto a product that is injection molded in the mold. Thus, contrary to the Examiner's assertion, Applicants did in fact challenge the Examiner's Official Notice and, therefore, the Examiner must now provide documentary evidence if the rejection is to be maintained.

According to MPEP 2144.03, Official Notice of facts not in the record is appropriate only in limited circumstances, and such rejections should be judiciously applied. MPEP 2144.03(A) goes on to state that "these circumstances should be rare when an application is under final rejection." Thus, Applicants first respectfully submit that the Examiner's assertion of Official Notice is not appropriate in the present case.

In any event, MPEP 2144.03(C) states that if the applicant challenges a factual assertion as not properly officially noticed or not based upon common knowledge, the Examiner must support the finding with adequate evidence. In the present case, Applicant sufficiently challenged the Official Notice taken in the February 14, 2006 Office Action. Therefore, it was upon the Examiner to provide documentary evidence in the next Office Action if the rejection is to be maintained. (See MPEP 2144.03(C)). The Examiner has not yet provided such evidence.

Moreover, if the Examiner felt that the Applicants' traverse of the Official Notice assertion was inadequate, MPEP 2144.04(C) further requires the Examiner to provide an explanation as to why it was inadequate. To date, the Examiner has neither provided documentary evidence to support his assertion of Official Notice, nor provided an explanation as to why Applicants' challenge of the Examiner's assertion was inadequate. Accordingly, for all of these reasons, it is respectfully submitted that the continuing rejection based on Official Notice is improper and, therefore, the Final Office Action should be withdrawn.

Claim Rejections – 35 USC §103

Also in the Office Action, Claims 40-43, 50, 52, 55-58, 65, 67-71, 73-82, 85 and 87 have been rejected under 35 U.S.C. §103(a) as being unpatentable over PCT Publication No.

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WO 97/20315 to Heiligers et al. in view of U.S. Patent No. 5,868,986 to Foulkes and U.S. Patent No. 6,255,948 to Wolpert et al. The Examiner has concluded that the claims are obvious in view of the combination of the above cited references. Applicants respectfully traverse this rejection.

First, the Examiner is of the opinion that the Heiligers publication is very relevant to the method according to Claim 69. Applicants respectfully disagree. With respect to the Examiner's assertion that Heiligers discloses a method for manufacturing a storage device on page 5, lines 3-7, such method is neither explicitly nor implicitly disclosed. Moreover, the rest of this document is silent about any method for manufacturing a storage device. Instead, the entire reference is only dedicated to the storage device itself. Nowhere in Heiligers is there any mention of a method for manufacturing a storage device.

Therefore, Heligers fails to teach or suggest any of the following method steps according to Claims 69 and 88:

1. no step of positioning an authentication means is disclosed;
2. no authentication means are disclosed to have authentication information unique to the individual CD or DVD to be stored in said storage device;
3. the means are not disclosed to be positioned in a mold for injection molding one of the first and second covers;
4. the authentication means are not disclosed to provide a surface against which injected plastic is molded;
5. no transparent plastic is disclosed to be injection molded against or around the authentication means in said mold;
6. the authentication means are not disclosed to be unable to be removed from the first or second cover without damaging the authentication means and/or the first or second cover;
7. no CD or DVD is disclosed to be loaded in the storage device; and

8. the printing and the CD or DVD are not disclosed to be visible through the first or second cover.

Turning to the Foulkes patent, this patent only discloses an in mold label for thermoforming polypropylene sheets to form margarine tubs (see column 3 line 63). These sheets are not transparent, and are not molded into a mold. On the contrary, they are thermoformed. Foulkes too is silent about a myriad of features set forth in method Claims 69 and 88:

1. No method for manufacturing a product comprising a compact disk (CD) or Digital Video Disc (DVD) in a storage device is disclosed;
2. No storage device is disclosed having a first and second cover pivotally connected;
3. No authentication means are disclosed;
4. No authentication means comprising a printing having authentication information unique to the individual CD or DVD to be stored in the storage device is positioned in a mold;
5. No mold for injection molding one of the first and second cover is disclosed;
6. No surface is provided against which injected plastic is molded;
7. No transparent plastic is injection molded against or around the authentication means in the mold;
8. No authentication means are disclosed that cannot be removed from said first or second cover without damaging said authentication means and/or the first or second cover;
9. No CD or DVD is loaded in the storage device; and
10. No printing and no CD or DVD is visible through said first or second cover;

Moreover, a combination of these documents would not provide the skilled man any hint, motivation, teaching or suggestion to apply in mold authentication means to uniquely authenticate CD's or DVD's. Furthermore since these cited documents are from such remote

and distinct fields, a combination thereof can only be sought for and found with impermissible hindsight bias.

Furthermore, the problem of authenticating the packaging with respect to the product i.e. margarine simply does not occur in the field of margarine tubs. Accordingly, there is absolutely no motivation to form a combination of the above mentioned documents.

The same arguments apply to the Wolpert patent. Specifically, the features of Claims 69 and 88 that are missing in this document are:

1. No method for manufacturing a product comprising a compact disk (CD) or Digital Video Disc (DVD) in a storage device is disclosed;
2. No storage device is disclosed having a first and second cover pivotally connected;
3. No authentication means comprising a printing having authentication information unique to the individual CD or DVD to be stored in the storage device is positioned in a mold;
4. No surface is provided against which injected plastic is molded;
5. No transparent plastic is injection molded against or around the authentication means in the mold;
6. No authentication means are disclosed that cannot be removed from said first or second cover without damaging said authentication means and/or the first or second cover;
7. No CD or DVD is loaded in the storage device; and
8. No printing and no CD or DVD is visible through said first or second cover.

Accordingly, a combination of Heiligers and Wolpert would not provide the skilled man any hint, motivation, teaching or suggestion to apply in mold authentication means to uniquely authenticate CD's or DVD's.

Furthermore, as discussed above with respect to the Examiner's assertion of Official Notice, the Examiner is requested to present relevant evidence to support his statement that

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placing a printer head adjacent a surface of an injection mold in order to manufacture CD/DVD covers, as defined in Claim 88, is known. The Examiner is further requested to provide evidence to support his statement that a carrier having printing on both sides for inserting a label in a mold for manufacturing CD/DVD covers, as defined in Claim 103, is known. If no evidence can be presented, the Examiner can only agree that these claims concern inventive subject matter. Accordingly, it is respectfully submitted that independent Claims 69 and 88, and the claims that depend therefrom, patentably distinguish over the prior art.

Conclusion

In view of the foregoing amendment and remarks, favorable consideration and allowance of the application with Claims 46, 48-49, 51-66, 68-77, 83 and 88-104 are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicants' attorney at the telephone number listed below.

Respectfully submitted,



Steven T. Zuschlag
Registration No.: 43,309
Attorney for Applicants

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550
STZ/mf

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